

Applic. No. 10/673,961
Response Dated August 5, 2004
Responsive to Office Action of March 30, 2004

Remarks:

Reconsideration of the application is requested.

Claims 1, 2, 4, 6 to 11, 13, 15 to 17, 19, 21, and 22 remain in the application. Claims 3, 5, 12, 14, 18, and 20 have been canceled to facilitate prosecution of the instant application.

In item 3 on pages 2 to 3 of the above-identified Office action, claims 1 to 3, 6 to 12, 15 to 18, and 21 to 22 have been rejected as being fully anticipated by Harth, III et al. (U.S. 5,661,241; hereinafter "Harth") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a method for the ultrasound measuring of layer thicknesses in cladding tubes for nuclear fuel, which comprises:

providing a high-frequency probe with a coupling surface having a planar surface region;

wetting the tube with a coupling medium; and

coupling the planar surface region with a wetted surface of the tube by a contact technique.

Claim 8 calls for, *inter alia*, a method for the ultrasound measuring of layer thicknesses, including the steps of:

providing a high-frequency probe with a coupling surface having a planar surface region;

wetting a nuclear fuel cladding tube with a coupling medium;

coupling the planar surface region with a wetted surface of the cladding tube by a contact technique; and

measuring a thickness of a liner layer of the cladding tube.

Claim 16 calls for, *inter alia*, a method for the ultrasound measuring of layer thicknesses in cladding tubes for nuclear fuel, including the step of:

coupling, by a contact technique, a planar surface region of a coupling surface of a high-frequency probe with a tube surface wetted with a coupling medium.

It is respectfully noted that Harth relates to a thickness measurement of non-metallurgically bonded cladding on the inside surface of vessels. Contrary thereto, the invention pertains to the measurement of partial layer thicknesses of thin-walled tubes. These are, particularly, the cladding tubes of fuel rods of a nuclear reactor that has a metallurgically bonded liner layer.

Clearly, Harth does not show the method as recited in claims 1, 8, and 16 of the instant application.

In item 4 on pages 3 to 4 of the above-identified Office action, claims 1 to 3, 6 to 12, 15 to 18, and 21 to 22 have been rejected as being obvious over Harth in view of Krautkramer et al. (hereinafter "Krautkramer") under 35 U.S.C. § 103.

In item 5 on page 4 of the above-identified Office action, claims 4, 5, 13, 14, 19, and 20 have been rejected as being obvious over Harth in view of Trulson et al. (U.S. 5,038,615; hereinafter "Trulson") under 35 U.S.C. § 103.

In item 6 on pages 5 to 6 of the above-identified Office action, claims 4, 5, 13, 14, 19, and 20 have been rejected as being obvious over Harth in view of Krautkramer and further in view of Trulson under 35 U.S.C. § 103.

It is respectfully noted that the combination of Harth with Krautkrämer or Trulson does not suggest the present invention. Neither of these documents pertains to layer thickness measurement on thin-walled tubes.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems,

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Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Harth to incorporate the features of Krautkrämer or Trulson, and there is no teaching or suggestion in Krautkrämer or Trulson to incorporate the features of Harth.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example,

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Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Harth or Krautkrämer or Trulson or to combine Harth's and Krautkrämer's and Trulson's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Harth or Krautkrämer or Trulson or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either

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show or suggest the features of claims 1, 8, or 16. Claims 1, 8, and 16 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 1, 8, or 16.

In view of the foregoing, reconsideration and allowance of claims 1, 2, 4, 6 to 11, 13, 15 to 17, 19, 21, and 22 is solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

The extension fee for response within a period of two (2) months pursuant to Section 1.136(a) in the amount of \$420.00 in accordance with Section 1.17 is enclosed herewith.

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Please charge any other fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,

For Applicant

GLM:lf

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